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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,573	05/18/2004	Dimitri Chernyak	018158-024000US	6344
20350 7590 12/29/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
SHAY, DAVID M				
ART UNIT		PAPER NUMBER		
3769				
MAIL DATE		DELIVERY MODE		
12/29/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/849,573

Applicant(s)

CHERNYAK, DIMITRI

Examiner

david shay

Art Unit

3769

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on September 22, 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date September 22, 2009

As an initial matter, applicant's remarks assert that claims "1-22 and 29-42 remain pending in the application....claim 23 has been cancelled". However, as claims 23-28 appear on pages 6-8 of the instant response all bearing status identifiers other than (Cancelled), the examiner will treat these claims as still pending.

The amendment filed September 22, 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "the central zone extends across a pupil center".

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure is silent on "the central zone extends across a pupil center".

Claims 1-9, 11-18, 20-26, 41, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Largent in combination with Dunn. Largent teaches providing concentric ablation areas of both far and near vision corrections in each eye, centered on the optical center of the eye, thus providing the claimed peripheral curvatures, and providing a mid range aspherical ablation which will increase the distance vision in a near sighted eye and the near

vision in a far sighted eye; the diameter of the central zone will have some numerical relationship to one of the many diameters the pupil can assume and can therefore be considered “scaled” thereto by the factor of the numerical relationship; and the near vision in a far sighted eye, and as can be seen from the power graph in Figure 3, also provides the claimed transition zones. Dunn teaches that it is common practice in multifocal lens fitting to have one lens with a central zone for near vision and the other with a central zone for far vision. It would have been obvious to the artisan of ordinary skill to provide central zones with near correction in one eye and distance correction in the other, since this is a recognized technique for providing treatment for presbyopia using multifocal lenses, and to provide an unablated zone in the central region, for example if the central region was already at the desired curvature for the multifocal shape, and to provide the specific diopter corrections recited, since these are well within the scope of one having ordinary skill in the art, are not critical, and provide no unexpected result, thus producing a device and method such as claimed.

Claims 5, 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Largent in combination with Dunn, as applied to claims 1-26, 41 and 42, and further in combination with Talamo et al. Talamo et al teach employing a measurement of the pupil size, noting that it is very important when planning optical zone size (see the instant remarks, the paragraph bridging pages 11 and 12). It would have been obvious to the artisan of ordinary skill to scale the optical zone size to the pupil size in the method of Largent, because this is very important, as taught by Talamo et al, thus producing a method such as claimed.

Claims 27-30, 32, 36, 37, 39, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Largent in combination with Dunn, as applied to claims 1-26, 41 and 42, and

further in combination with McMillen et al. McMillen et al teach employing a tangible medium to instruct a processor to control an optical system to cause a laser to ablate an eye according to a treatment table. It would have been obvious to the artisan of ordinary skill to employ the medium and treatment table of McMillen et al in the device of Largent, because Largent doesn't provide any details regarding the laser scanning system to recurve the eye, thus one of ordinary skill in the art would of necessity look to the laser cornea recurving art to determine the form such a system would take, thus producing a system such as claimed.

Claims 31, 33-35, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Largent in combination with McMillen et al. Largent and McMillen et al provide the teachings set forth above. It would have been obvious to the artisan of ordinary skill to provide an unablated zone in the central region, for example if the central region was already at the desired curvature for the multifocal shape and to provide the specific diopter corrections recited, since these are well within the scope of one having ordinary skill in the art, are not critical, and provide no unexpected result, thus producing a device and method such as claimed.

Applicant's arguments with respect to claims 1-42 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Johnson, can be reached on Monday through Friday from 7:00 a.m. to 3:30 p.m. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/david shay/
Primary Examiner, Art Unit 3769